

REMARKS

This amendment is submitted in response to the Office Action dated March 6, 2006. Applicant has amended the claims to clarify the claims in a manner that overcomes the previous Examiner's rejections under 35 U.S.C. § 101 and 35 U.S.C. § 112. No new matter has been added, and the amendments place the claims in condition for allowance. The discussion and arguments provided below reference the claims in their amended form. Applicant has amended Claims 3-5, 11-13 and 18-21. Claims 2-5, 10-13, and 18-21 are currently pending.

Applicant notes with appreciation the courtesies extended by Examiner William Vaughn in the series of four telephone conferences extending from July 5 through July 21. The diligence of Examiner Vaughn in helping expedite the prosecution of this application despite the departure of Examiner Marc Thompson has been very helpful to the Applicant.

I. ALLOWABLE SUBJECT MATTER

In the present office action, the previous Examiner has noted the allowability of the subject matter of Claims 2-3, 10-11 and 18-19, which were not subject to any prior art rejection under 35 U.S.C. § 102 or 35 U.S.C. § 103. Applicant has amended the claims to clarify the claims in a manner consistent with the advice provided in the previous Examiner's rejections under 35 U.S.C. § 101 and 35 U.S.C. § 112.

II. CLAIMS REJECTIONS UNDER 35 U.S.C. § 112

At paragraph 9, the Examiner has rejected Claims 18-21 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Alternatively, the Examiner has rejected the same claims under 35 U.S.C. § 112, first paragraph, as based on a disclosure that is not enabling. The Examiner observes that the specification fails to disclose what a "computer-readable medium"

constitutes, but observes that a “computer usable medium” is disclosed. Applicant has amended Claims 18-21 to recite a “computer usable medium.

At paragraph 12, the Examiner has rejected Claims 2-3, 10-11 and 18-21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as his invention. Specifically, the Examiner observes that Claim 3 recites “one of the set of discovering at least one keyword within the page and automatically generating said group of keywords”, but that no positive recitation of “discovering at least one keyword” is provided. Applicant has amended Claims 3, 11, and 19 to recite “discovering at least one keyword”.

At paragraph 14, the Examiner has rejected claims 18-21 for reciting a ‘computer-readable medium’. Applicant has amended Claims 18-21 to recite a “computer usable medium”. The Examiner alleges that Applicant has supplied no indication as to what types of “computer usable medium” the limitation is attempting to describe. Applicant respectfully submits that the Applicant has described computer usable media in tangible and definite terms at page 8, line 11 of the specification. The relevant paragraph states

“Examples of computer usable mediums include: nonvolatile, hard-coded type mediums such as read only memories (ROMs) or erasable, electrically programmable read only memories (EEPROMs), recordable type mediums such as floppy disks, hard disk drives and CD-ROMs, and transmission type mediums such as digital and analog communication links.”

Applicant respectfully reminds the Examiner that a broad claim is not indefinite by mere virtue of its breadth. Specifically M.P.E.P. § 2173.04 points out that,

“Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. § 112.”

Applicant respectfully submits that, in the presence of a specific explanation from the present specification of illustrative examples of computer-usable media, the Examiner's objection to the recitation of a 'computer readable medium' represents a rejection for breadth, which rejection is facially improper. Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. § 112 are overcome.

III. CLAIMS REJECTIONS UNDER 35 U.S.C. § 101

In the present Office Action, the Examiner has rejected Claims 18-21 under 35 U.S.C. § 101 for non-statutory subject matter because the Examiner believes that the application fails to limit the subject matter to tangible items. Applicant has amended the claims to comply with the recommendation of the Examiner by reciting a 'tangible computer usable medium'.

IV. CLAIMS REJECTIONS UNDER 35 U.S.C. § 102

In the present Office Action, Claims 4, 12 and 20 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,832,350 to Bates, *et al.* (*Bates '350*). Likewise, Claims 4, 12 and 20 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0040311 by Douglass, *et al.* (*Douglass*). Applicants respectfully traverse the Examiner's rejections, because specific recited features of amended Claims 4, 12 and 20 are absent from both *Bates '350* and *Douglass*.

Applicant has amended Claims 4, 12 and 20 to recite "searching the page for keywords, wherein the step of searching the page for keywords further comprises the browser client performing one of a set consisting of discovering at least one keyword within the page and responsive to discovering an absence of keywords within metadata for the page, automatically generating a group of keywords based on the content of the page". This limitation is also present in Claim 3, which the Examiner has previously indicated to be allowable.

The Examiner has at no point asserted, and Applicant does not believe, that either of *Bates '350* or *Douglass* discloses "searching the page for keywords, wherein the step of

searching the page for keywords further comprises the browser client performing one of a set consisting of discovering at least one keyword within the page and, responsive to discovering an absence of keywords within metadata for the page, automatically generating a group of keywords based on the content of the page” Applicant believes that this amendment to Claims 4, 12, and 20 overcomes the rejection of Claims 4, 12 and 20 under 35 U.S.C. § 102(e) as being anticipated by *Bates ‘350*. Likewise, Applicant believes that this amendment to Claims 4, 12, and 20 overcomes the rejection of Claims 4, 12 and 20 under 35 U.S.C. § 102(e) as being anticipated by *Douglass*.

V. CLAIMS REJECTIONS UNDER 35 U.S.C. § 103

In the present Office Action, Claims 5, 13, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bates ‘350* in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made. The Examiner has further rejected Claims 5, 13, and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Douglass* in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made. As set forth in MPEP 2142, “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicants respectfully traverse the Examiner’s rejections, because specific recited features of amended Claims 5, 13 and 21 are neither taught nor suggested by the combination of *Bates ‘350* and *Douglass*. Applicant has amended Claims 5, 13 and 21 to recite “searching the page for keywords, wherein the step of searching the page for keywords further comprises the browser client performing one of a set consisting of discovering at least one keyword within the page and, responsive to discovering an absence of keywords within metadata for the page, automatically generating a group of keywords based on the content of the page”. This limitation is also present in Claim 3, which the Examiner has previously indicated to be allowable.

The Examiner has at no point asserted, and Applicant does not believe, that either of *Bates '350* or *Douglass* teaches or suggests “searching the page for keywords, wherein the step of searching the page for keywords further comprises the browser client performing one of a set consisting of discovering at least one keyword within the page and, responsive to discovering an absence of keywords within metadata for the page, automatically generating a group of keywords based on the content of the page” Applicant further believes that the combination of *Bates '350* or *Douglass* does not teach or suggest the recited feature. Applicant believes that this amendment to Claims 5, 13, and 21 overcomes the rejection of Claims 5, 13 and 21 under 35 U.S.C. § 103(a) as unpatentable over *Bates '350* in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made. Likewise, Applicant believes that this amendment to Claims 5, 13, and 21 overcomes the rejection of Claims 5, 13 and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Douglass* in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made.

Further, Applicant respectfully submits that the Examiner has not stated a *prima facie* case of obviousness because the combination of *Bates '350* and “what would have been obvious to one of ordinary skill in the art at the time the invention was made” does not teach or suggest “allowing the user to selectively enable automatic updates of the keyword field of an entry in the hotlist of pages whenever the page represented by the entry is accessed.” The Examiner alleges that “provision for user editing of the entries was evident, inter alia, in Column 13, Lines 47-55. ...and the automation of a manual activity is considered obvious to one skilled in the art.” With respect to the step of, “allowing the user to edit the keyword field of the entry in the hotlist of pages”, the Examiner states:

Bates '350 disclosed organization and effective categorization of bookmarks... The keyword information was stored in association with the bookmark entr(ies). Further provision for user editing of the entries was made, inter alia, in Column 13, Lines 47-55.

Applicants respectfully submit that the cited passage in *Bates '350* does not disclose "allowing the user to edit the keyword field of the entry in the hotlist of page" as is alleged by the Examiner with respect to exemplary Claim 5.

Applicant has examined the cited portion of *Bates '350*. In Column 13, Lines 47-55, *Bates '350* discloses:

Referring to **FIG. 12**, the edit affinity routine beginning in block **194**, first referenced in **FIG. 4** of the browser main routine **180**, provides an opportunity for a user to manually edit an affinity. In the illustrative embodiment, it further includes displaying the affinities found to the user in block **345** for his or her review, e.g., in a dialog box. This could also include an opportunity if no affinities have been automatically found for the user to manually insert all of the information for an affinity.

The referenced passage describes editing an affinity, which does not disclose editing a keyword. Affinities, as disclosed in the abstract of *Bates '350*, refer to associations between links, which, as are described below, may be based on mutually held keywords. The abstract of *Bates '350* clearly states the nature of affinities, as distinct from keywords, when the abstract discloses:

An apparatus, program product, and method utilize a "bookmark affinity" to facilitate organizing by mutual affinity stored storage location addresses, or "bookmarks," each for a given hypertext document. This *affinity is found by comparing specific criteria of the addressed hypertext document, such as relatedness of address path, keywords in the document description*, word count of non-trivial words, and shared out-bound storage location addresses, or "links." These affinities allow presenting related bookmarks to aid in finding the desired hypertext document. (*emphasis supplied*).

Applicant has further examined each instance of the word 'keyword' in the text of *Bates '350* and has found no reference to the user-editing of keywords. Applicants respectfully submit that *Bates '350* does not teach or suggest the features of Applicant's amended exemplary Claim 5 because Applicant's recited feature of "allowing the user to edit the keyword field of the entry in the hotlist of pages" is neither taught nor suggested by the cited reference.

Applicant further respectfully submits that *Bates '350* is ineligible as a prior-art reference under 103(a). With respect to the present Office Action, the Examiner has asserted at paragraph 20 that *Bates '350* is prior art under 35 U.S.C. § 102(e). Additionally, the face of the *Bates '350* reference indicates that *Bates '350* is assigned to International Business Machines, the assignee of Applicants' current application under the assignment recorded at Reel 011225 and Frame 0869 on October 26, 2006. Further, *Bates '350* states on its face that it was invented by Cary Lee Bates and Paul Reuben Day, an inventive entity distinct from the current Applicants (Bruce A. Beadle, Miguel Sang and Ramdolph M. Forlenza). The present application was filed on October 26, 2000, after the critical deadline of November 29, 1999. A declaration of these facts under 37 C.F.R. §1.132 is included herewith in support of this response.

CONCLUSION

Applicants have diligently responded to the Office Action by amending the claims to overcome the Examiner's rejections under 35 U.S.C. § 101 and 35 U.S.C. §112, and Applicants have addressed the art cited by the Examiner in his rejection under 35 U.S.C. §102 and 35 U.S.C. §103. Because the amendments and arguments overcome all rejections, Applicants respectfully request issuance of a Notice of Allowance for all claims now pending.

Applicant further respectfully requests the Examiner contact the undersigned attorney of record at 512.343.6116 if such would further or expedite the prosecution of the present Application.

Respectfully submitted,



James E. Boice
Reg. No. 44,545
Dillon & Yudell LLP
8911 North Capital of Texas Highway
Suite 2110
Austin, Texas 78759
512.343.6116

ATTORNEY FOR APPLICANT(S)